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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,166	10/16/2001	Kent D. Vincent	10005747-1	5610

7590 03/18/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

AHMED, SHEEBA

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,166

Applicant(s)

VINCENT ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) 56, 63 and 68-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55, 57-62 and 64-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/6/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. The finality of the rejection of the last Office action is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow. Any inconvenience to the Applicants is regretted.

Terminal Disclaimer

2. The terminal disclaimer filed on September 23, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of U.S. Patent 6,556,470 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Amendment

3. The Preliminary Amendment filed on September 16, 2002, amending claims 27-40 and 59-61 and adding new claims 48 and 64-70, contains claim-numbering errors. The numbering of claims in the clean copy of claims does not match the numbering of claims in the marked-up copy of claims. Applicants are required to submit a complete listing of all claims with correct claim numbers to clarify the record.

Claims 1-70 are pending with claims 56, 63, 68-70 withdrawn from consideration.

Claims 1-55, 57-62, and 64-67 are now under consideration.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 17-19, 20, 21, 23-25, 34, 36-43, 45, 49-52, 62, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheridan (EP 0427 507 A2).

Sheridan discloses an addressable display system including a paper sheet comprising a light transparent host layer loaded with a plurality of repositionable elements, the elements being movable from a first orientation in which they present a first visual appearance, to a second orientation in which they present a second visual appearance, and the independent external addressing means which affects the orientation of the repositionable elements (Abstract). The spherical balls have at least two dissimilar surfaces of contrasting colors and differential surface charges (Page 3, lines 9-14). All limitations of claims 1, 17-19, 20, 21, 23-25, 34, 36-43, 45, 49-52, 62, and 64 are disclosed in the above reference.

5. Claims 1-4, 17-19, 20, 21, 23-25, 34, 36-43, 45, 49-52, 62, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Sheridan (US 5,389,945).

Sheridan discloses an addressable display system including a paper sheet comprising a light transparent host layer loaded with a plurality of repositionable elements, the elements being movable from a first orientation in which they present a

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first visual appearance, to a second orientation in which they present a second visual appearance, and the independent external addressing means which affects the orientation of the repositionable elements (Abstract). Upon application of an electric field of a given polarity and of a potential higher than a threshold value, the balls line up so that their black sides all face in one direction. When viewed from that direction, the display sheet will appear to be black. Conversely, the polarity of the electric field will cause the balls to rotate 180° so that their white sides face in the viewing direction and the display will appear white (Column 4, lines 14-22). All limitations of claims 1-4, 17-19, 20, 21, 23-25, 34, 36-43, 45, 49-52, 62, and 64 are disclosed in the above reference.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 50-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 16-20 of U.S. Patent

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No. 6,809,956 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

U.S. Patent 6,809,956 B2 claims a method for writing on electrical field addressable rewritable medium wherein the method comprises providing a substrate having at least one layer of a molecular colorant coating wherein the colorant is at least bichromal and subject to switching between color states under the influence of the electrical field forming pixels in the substrate and electrically addressing pixels to form document content. Claims 50-55 of the instant application, on the other hand, claims a method of fabricating a rewritable display screen by depositing a layer of bimodal molecular colorant on a surface and providing addressable elements adjacent said substrate to address said surface as addressable picture elements.

Accordingly, it would have been obvious to one having ordinary skill in the art to use the rewritable display screen claimed in the instant application to form document content.

7. Claims 1-49, 62, and 64-67 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 and 35-39 of U.S. Patent No. 6,731,532 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other.

U.S. Patent 6,731,532 B2 claims an erasable writing medium comprising a substrate and at least one layer of a molecular colorant coating affixed to the substrate

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and wherein the molecules of the coating are at least bichromal and selectively switchable between color states under the influence of a localized electric field.

Claims 1-49, 62, and 64-67 of the instant application, on the other hand, claim an electronically addressable display comprising a substrate with an addressable display bi-modal molecular colorant stratum and an addressing device associated with the molecular stratum to selectively switch the colorant molecules of the stratum between at least two visually distinguishable states.

Accordingly, it would have been obvious to one having ordinary skill in the art to add an addressing device next to the molecular colorant coating affixed to the substrate, as claimed in U. S. Patent 6,731,532 B2, given that such a device would be needed to selectively switch the colorant molecules of the colorant coating between the at least two visually distinguishable states.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed

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March 10, 2005